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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/581,884

06/06/2006

Son Nguyen Kim

13111-00043-US1

4956

30678

7590

03/26/2010

CONNOLLY BOVE LODGE & HUTZ LLP

1875 EYE STREET, N.W.

SUITE 1100

WASHINGTON, DC 20006

EXAMINER

NGUYEN, VU ANH

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/581,884	<b>Applicant(s)</b> KIM ET AL.	
	<b>Examiner</b> Vu Nguyen	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 33-57 and 60 is/are pending in the application.
- 4a) Of the above claim(s) 43 and 45-55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33-42, 56, 57 and 60 is/are rejected.
- 7) ☒ Claim(s) 44 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This Office action is in response to the amendment filed 02/12/2010, wherein all the pending claims have been amended. Claims 43 and 45-55 remain withdrawn as directed to non-elected species; claims 1-32, 58, 59 and 61-67 have been cancelled. Claims 33-42, 44, 56, 57 and 60 are being examined on the merits.

### ***Election/Restrictions***

2. The request, made in the remarks filed 02/12/2010, for claims 43 and 45-55 to be rejoined upon allowance of the generic claim 33 is acknowledged. However, claim 33 is not in condition for allowance as will be shown below.

### ***Claim Objections***

3. Claim 33 is objected to because of the following informalities: incorrect spelling of the term "hairspray". Appropriate correction is required.

4. Claim 44 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 44 recites "The hairspray composition according to claim 33, which consists of repeating units of...". How can the composition of claim 33 consist of the recited monomers when the

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composition of claim 33 necessarily contains a carrier? Claim 44 should be amended to read: "The hairspray composition according to claim 33, wherein the monomer mixture consists of..." or "The hairspray composition according to claim 33, wherein the at least one copolymer consists of repeating units of..."

***Claim Rejections - 35 USC § 102***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Rationales for the following rejections have been set forth in previous Office action.
7. Claims 33-36, 40-42, 56, 57 and 60 are rejected under 35 U.S.C. 102(b) as being anticipated by Dausch et al. (WO02/38638).
8. Claims 33-40, 56, 57 and 60 are rejected under 35 U.S.C. 102(b) as being anticipated by Kim et al. (WO01/62809).
9. Note that both references disclose hairspray compositions (see examples in both references).

***Allowable Subject Matter***

10. Claim 44 would be allowable if rewritten to overcome the objection set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

11. Applicant's arguments filed 02/12/2010 have been fully considered but they are not persuasive. Specifically, the applicant alleges that neither reference teaches a composition comprising a copolymer which necessarily contains tert-butyl acrylate and acrylic acid, and that both references employ methacrylic acid instead of acrylic acid in the examples. Applicant also points to examples in the specification tending to show the criticality of using acrylic acid instead of methacrylic acid. First, the showing of criticality is irrelevant as the rejections are based on anticipation, not obviousness. Second, the scope of the prior art disclosure is not limited to that disclosed in the examples. The fact remains that Dausch teaches a hairspray composition comprising a copolymer made from a monomer mixture comprising (A) tert-butyl acrylate and/or tert-butyl methacrylate, and (B) acrylic acid and/or methacrylic acid (B) (see abstract). Such teaching necessarily includes a copolymer comprising tert-butyl acrylate and acrylic acid. Similarly, Kim teaches a hairspray composition comprising a copolymer made from a monomer mixture comprising component (a) which preferably includes tert-butyl acrylate [0052] and component (d) of which "preference is given to the monomers acrylic acid and methacrylic acid" [0090]. Such teaching necessarily includes a copolymer comprising tert-butyl acrylate and acrylic acid.

### ***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vu Nguyen whose telephone number is (571)270-5454. The examiner can normally be reached on M-F 7:30-5:00 (Alternating Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Vu Nguyen  
Examiner  
Art Unit 1796

/David Wu/  
Supervisory Patent Examiner, Art Unit 1796